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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/051,461	01/22/2002	Ulrich Windmoller	TPP 31434	6981

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EXAMINER

YAO, SAMCHUAN CUA

ART UNIT	PAPER NUMBER
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1733

DATE MAILED: 05/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/051,461	Applicant(s) WINDMOLLER ET AL.	
	Examiner Sam Chuan C. Yao	Art Unit 1733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 3-8 and 10-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2 and 9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>01-22-02</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's election with traverse of Group I Species A (claims 1-2 and 9) on 04-13-04 is acknowledged. The traversal is on the ground(s) that "... a search of the subject matter of the elected species would, of necessity, overlap the search area of the non-elected species." This is not found persuasive because, the various recited species are patentably distinct from one another. For this reason, this is a prima facie evidence that, it would be burdensome for the examiner to consider the recited species. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

The requirement is still deemed proper and is therefore made **FINAL**.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-2 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is indefinite, because a broad limitation followed by linking terms (e.g., in particular) and a narrow range or limitation within the broad range or limitation is

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considered indefinite since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Moreover, this claim is indefinite, because it is unclear what resin or material is taken to be similar to an aminoplast resin.

Claim Rejections - 35 USC § 102/103

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Cannady, Jr. (US 4,540,624).

Cannady, Jr. discloses a decorative laminate having a print sheet (12) and core sheets (11), the print sheet comprises a melamine-formaldehyde resin impregnated paper sheet, wherein the paper sheet and the core sheets, each includes uniformly distributed carbon fibers to provide an anti-static characteristic to the decorative laminate (abstract; col. 1 lines 7-33; col. 3 lines 11-67; figures 1-2). As for a recited limitation of “*particles of an electrically conducting material are applied to the back of decorative paper*”, this limitation is taken to read on the

paper print sheet having uniformly distributed carbon fibers (i.e. electrically conducting material), because the carbon fibers must be present throughout (i.e. top surface, core section, and back surface) the paper sheet, since as noted earlier, the carbon fibers are uniformly distributed.

Alternatively, the above limitation also reads on core sheets having uniformly distributed carbon fibers which are applied on the back surface of the paper print sheet.

With respect to claim 9, it is taken that, a topmost layer and the remaining bottom layers of the core sheets are taken to be the recited support layer and the recited counteracting layer, respective. Note that, the remaining bottom layers are capable of preventing the topmost layer from curling since these provide structural rigidity to a resultant decorative laminate (col. 3 lines 26-34).

7. Claims 1 and 9 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over EP 0,248,237.

EP '237 discloses a conductive laminated paper sheet (3) comprising a decorative melamine-resin treated paper surface layer (5) and a resin impregnated paper core layer (4), wherein the surface layer "*contains finely divided metal powder*" (abstract; figure). It is reasonably expected that, to a certain extent, some finely divided metal powder is present around the back surface of the paper layer since the powder is expected to be distributed throughout the paper layer. In any event, it would have been obvious in the art to uniformly distribute finely divided metal powder in forming a paper layer of EP '237, because it is a notoriously common practice in the art to uniformly blend various

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components in forming a paper web. It directly follows that, a back surface of a paper layer taught by EP '237 must contain to a certain extent "*contains finely divided metal powder*".

With respect to claim 9, a core layer (4) and chipboard (1) are taken to be a support layer and a counteracting layer, respectively.

8. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over EP 248237 as applied to claim 1 above, and further in view of JP 4-145992 A.

It is unclear what type of electrically conductive metallic powder is disclosed in the EP '237 patent. In any event, it would have been obvious in the art use iron powder in forming a paper layer taught by EP '237, because iron powder is a well known material in the art to have "*an excellent electric conductivity*" and it is also known to provide an antistatic function as exemplified in the teachings of JP '992 (abstract).

9. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cannady, Jr. (US 4,540,624) as applied to claim 1 above, and further in view of Mehta et al (US 5,879,781).

Note: this claim was taken to be anticipated by Cannady, Jr. in numbered paragraph 6. This alternative rejection is made in case a limitation "*counteracting layer*" defines over the remaining bottom layers of core sheets.

It would have been obvious in the art to provide a backing sheet onto an underside surface of core sheets, because Mehta et al discloses providing a

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backing sheet to a core sheet in order to prevent a resultant decorative laminate from warping (col. 2 lines 1-51; figure 1).

10. Claims 1-2 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 248237 A1 in view of Dong et al (US 2002/0136862) and Hellmann et al (US 4,906,497).

Note: claims 1 and 9 are taken to be anticipated by EP '237 in numbered paragraph 7 above. This alternative rejection is made in case the limitation *"particles of an electrically conducting material are applied to the back of decorative paper"* defines over paper sheet taught by EP '237.

EP '237 further teaches the decorative laminated paper sheet (3) is adhesively bonded onto a chipboard (1). EP '237 is silent on the type of adhesive which is used for bonding a decorative sheet and a chipboard together. However, it would have been obvious in the art to use a microwave activated hot-melt adhesive containing metallic particles as well as anti-static agents, because: a) it is old in the art to use hot-melting adhesive for bonding decorative layer and base layer in forming a decorative laminated panel as exemplified in the teachings Dong et al (numbered paragraphs: 0019, 0103; 0119-0122); and, b) Hellmann et al discloses incorporating metallic particles in forming a microwave activated hot-melting adhesive in order to enhance the heating rate of the adhesive and further suggests incorporating antistatic agents to the adhesive, wherein the adhesive is suitable for making flooring articles (abstract; col. 1 lines 1-11; col. 4 line 10 to col. 5 line 10).

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With respect to claims 2 and 9, these claims would have been obvious in the art for the same reasons set forth in numbered paragraphs 8-9.


Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sam Chuan C. Yao whose telephone number is (571) 272-1224. The examiner can normally be reached on Monday-Friday with second Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (571) 272-1226. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Sam Chuan C. Yao
Primary Examiner
Art Unit 1733

Scy
05-14-04